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SHAH, AMEE A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/920,592

**Applicant(s)**

BODMER ET AL.

**Examiner**

AMEE A. SHAH

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 58-61, 64-67 and 73-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 58-61, 64-67 and 73-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 8/16/08

### **DETAILED ACTION**

Claims 1-19, 58-61, 74-67 and 73-79 are pending in this action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of an Information Disclosure Statement filed on August 16, 2008, has been entered and considered.

#### ***Response to Amendment***

Applicant's amendment, filed August 16, 2008, has been entered. Claims 1, 6-8, 58, 67 and 76 have been amended.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6-8 refer to a give second identifier. It is not clear to one of ordinary skill in the art what this second identifier comprises, i.e. where or how this second identifier is used

and what it identifies. For example, is the item of a third party supplier identified with a second identifier which may or not be included with the unique identifier or is each order generated identified with a second identifier? For purposes of this action only, the examiner will interpret the second identifier as a further limitation of the identifier of the item.

***Examiner Note***

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(c), (f) or (g) prior art under 35 U.S.C. §103(a).

**Claims 1-9, 16, 58-61, 67 and 76-79 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tam et al. 2002/0184116 A1, previously cited (hereafter referred to as “Tam ’116) in view of Tam et al., US 2002/0147656 A1, previously cited (hereafter referred to as “Tam 656”) and further in view of McIntyre et al., US 2005/0114232 A1, previously cited (hereafter referred to as “McIntyre”).**

Referring to claim 1. The prior art Tam ’116 teaches a method for an e-commerce retailer to display and sell items of a third party (e.g. Fig. 1) comprising: identifying each item of a third party supplier with a unique identifier (Figs. 5F and 8 and ¶¶0035 and 0036 – note the identifier can be the stock or UPC number, the retailer is the aggregator and the third party supplier is the seller); associating the unique identifier of the item with an image of the item, said image residing on a computer maintained by the third party supplier (Fig. 5F and ¶0035 – note that the seller selects an image file that can reside on “my computer,” i.e. the seller’s computer); and presenting at least some of the images of third party supplier items to the user for on-line commerce, (Fig. 8 and ¶0078-0079 – note the user is the buyer), with the seller maintaining the images on the seller computer (Fig. 5F). Tam ’116 also teaches a structure of holding product information for the purpose of selling (see, e.g., Fig. 2).

Tam '116 does not specifically teach associating the unique identifier with a user, retrieving the images from the seller's computer in response to a product request, identifying each item requested based in part on the identifier in response to a product request, and identifying and generating an order for each item to be sent to the appropriate third party seller.

The related application of the prior art Tam '656 teaches a system and method for e-commerce using a catalog wherein the images of the third party supplier items are presented by an e-commerce retailer in response to a product request from a user to the e-commerce retailer (¶¶0071 and 0076 – note the request is comprised of the registration information and the buying habits, and the e-commerce retailer is the aggregator), the product information residing in the seller's computer is retrieved by the aggregator (¶¶0021, 0025 and 0026 – note that the aggregator maintains a database of pointers product information maintained in the seller's databases and retrieves such information based on these pointers), and in response to an order request from the user to the e-commerce retailer for one or more items, identifying, based at least in part on said unique identifier, each item requested and an appropriate third party supplier for each requested item and automatically generating an order for each requested item to be transparently sent to the third party supplier (¶¶0037, 0038 and 0047 – note that the buyer selects to purchase one or more of the items from the aggregator catalog, i.e. an order request from the user, the products are identified by their related product numbers and, in order for the order send to the appropriate seller or fulfiller, the appropriate seller is inherently identified).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method and system of Tam '116 to include the teachings of Tam '656 to allow for the images to be retrieved from the seller's computer, to identify each item

requested based in part on the identifier in response to an order request, and to identify and generate an order for each item to be sent to the appropriate third party seller. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by and envisioned by Tam '656 in order to have a complete selling system with a complete catalog to facilitate the sale and delivery of goods and services (§§0006 and 0026) and because the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one ordinary skill in the art would have recognized that results of the combination were predictable.

Tam '116 and '656 do not specifically teach associating the unique identifier with a user and the product request being for at least one specific item of the third party.

McIntyre teaches a system and method for providing image goods and/or services to multiple parties at different locations including the known techniques of associating a unique identifier for a product such as an image with a user and identifying the user based on the identifier (§§0027 and 0031), and of retrieving images in response to a product request for a specific item (§0036 – note that a third party can view images based on the email and unique code and determine whether the order a print of the image, therefore the product request is the request to view the product of the image of which a print is for sale and that was referred by the email). These known techniques are applicable to the method of Tam '116 and '656 as they all share characteristics and capabilities, names they are directed to electronic shopping of items such as images.

One of ordinary skill in the art would have recognized that applying the known techniques of McIntyre would have yielded predictable results and resulted in an improved

method. It would have been recognized that applying the known techniques of McIntyre to the teachings of Tam '116 and '656 would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applies shows the ability to incorporate such references into similar methods. Further, including an association to a user in the unique identifier for each item, identifying the user based on the identifier, and retrieving images in response to a product request for a specific item, as taught by McIntyre, would have been recognized by those of ordinary skill in the art as resulting in an improved method that would provide for a more convenient way to share and purchase third party items such as images by allowing the user to more accurately and directly locate the item desired.

Referring to claims 2 and 3. The prior arts Tams and McIntyre further teach the method of claim 1 wherein the items include products and services (Tam '116, ¶0018 teaches products and services such as downloading and Tam '656, ¶0019 discusses how it is old in the art for retailers to sell products and services).

Referring to claim 4. The prior arts Tams and McIntyre further teach the method of claim 1 wherein the images of items include graphic images (Tam '116, Fig. 8).

Referring to claim 5. The prior arts Tams and McIntyre teach the method of claim 1 wherein the images of items include descriptive text (Tam '116, Fig. 8).



Referring to claim 6. The prior arts Tams and McIntyre teach the method of claim 1 wherein a given second identifier references a corresponding product Stock Keeping Unit (SKU) numbers (Tams '116, Figs. 5F and 8 and ¶¶0035 and 0036 – note the identifier can be or include the stock number).

Referring to claim 7. The prior arts Tams and McIntyre further teach the method of claim 1 wherein a given second identifier references pricing information from a third party (Tams '116, Fig. 5G and ¶¶0037 and 0070 discuss the third party including pricing information in the product description and referencing the information from the database and Tams '656, ¶¶0025 and 0084 teach referencing that information through the use of pointers).

Referring to claim 8. The prior art Tams and McIntyre further teach the method of claim 1 wherein a given second identifier references order fulfillment information (Tam '656, ¶0078 – note that the unique identifier is the transaction identifier and the order fulfillment information includes the seller, fulfiller (if any), and product information). One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would provide for a record of the transactions to be used in the future for such purposes as marketing or auditing.

Referring to claim 9. The prior arts Tams and McIntyre teach the method of claim 1, as discussed above, wherein said step of presenting includes: requesting images from a third party (Tam '116, Fig. 5F and ¶0035 – note that the request is performed by the request for information

submitted through the dialog boxes); receiving a list of Uniform Resource Locators (URLs) for said requested images (Tam '656, ¶¶0021, 0025 and 0125 – note the database contains a list of pointers to product information, including images, received from the sellers and that the pointers can be URLs); and displaying an on-line page that displays images retrieved from said URLs (Tam '116, Fig. 8).

Referring to claim 16. The prior arts Tams and McIntyre further teach the method of claim 1 wherein the images are rendered on a Web page for display to the user (Tams '116, Fig. 8).

Referring to claims 58-61, 67 and 76-79. All of the limitations in apparatus claims 58-61, 67 and 76-79 are closely parallel to the limitations of method claims 1-4, analyzed above and are rejected on the same bases.

**Claims 10-12, 17, 64 and 75 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams and McIntyre further in view of Baum, US 2002/0065741 A1, previously cited (hereinafter referred to as “Baum”).**

Referring to claim 10. The prior art Tams and McIntyre teach the method of claim 9, as discussed above, but do not teach wherein the request for images includes background and formatting information of a particular third party. Baum teaches a method for distributing images to multiple recipients including wherein requests for images from a third party to be presented to a user include background and formatting information of a particular third party

(¶¶0072 and 0075 – note that the products/services are photofinishing services/prints of photographic images and that the images of the product are the photographic images).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams and McIntyre to include the teachings of Baum to allow for the request for images includes background and formatting information of a particular third party. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to be able to consider alterations to the products/images that may better suit their purposes (¶0072).

Referring to claim 11. The prior art Tams and McIntyre teach the method of claim 1, as discussed above, but do not specifically teach wherein a particular third party provides photofinishing services and the images correspond to user photographic images. Baum teaches a method for distributing images to multiple recipients including wherein a particular third party provides photo-finish services and the images correspond to user photographic images (*see, e.g.,* ¶0011). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams and McIntyre to include the teachings of Baum to allow for a particular third party to provide photo-finish services and the images to correspond to user photographic images. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to be able to order image prints in a manner that minimizes the user's time, effort and expense (¶0012).

Referring to claim 12. The prior arts Tams and McIntyre teach the method of claim 1 wherein a given third party provides URLs for images, as discussed above, but do not specifically teach wherein URLs are provided for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. Baum teaches a method for distributing images to multiple recipients including wherein a given third party provides URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats (Figs. 5 and 9, and ¶0080).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams and McIntyre to include the teachings of Baum to allow for a given third party to provide URLs for images in various sizes and formats, thereby enabling retrieval and display of images to the user in various sizes and formats. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would allow users to have access to view images in various manners to better determine which image to order (¶¶0072 and 0075).

Referring to claim 17. The prior arts Tams and McIntyre teach the method of claim 1, as discussed above, but do not teach wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party. Baum teaches a method for distributing images to multiple recipients including wherein the unique identifier of an item requested by the user is employed for placing a fulfillment request with a corresponding third party (¶0075 – note the unique identifier is the number used to reorder).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams and McIntyre to include the teachings of Baum to allow for the unique identifier of an item requested by the user to be employed for placing a fulfillment request with a corresponding third party. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Baum that doing so would provide for a more seamless and accurate ordering system (§10075).

Referring to claims 64 and 75. All of the limitations in apparatus claims 64 and 75 are closely parallel to the limitations of method claim 17, analyzed above, and are rejected on the same bases.

**Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams and McIntyre further in view of Garfinkle et al. US 6,017,157, previously cited (hereinafter referred to as “Garfinkle”).**

Referring to claim 13. The prior arts Tams and McIntyre teach the method of claim 1 but do not specifically teach wherein a given third party initially provides smaller thumbnail images of the items and provides larger images in response to user requests. Garfinkle teaches a method of processing and distributing digital images wherein a party initially provides smaller thumbnail images of the items and provides larger images in response to user requests (col. 7, lines 4-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams and McIntyre to include the teachings of Garfinkle to allow for a given third party to initially provide smaller thumbnail images of the

items and to provide larger images in response to user requests. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so allow for suppliers to provide more details at once on a single page by showing a small depiction of a product with larger depictions available upon request, thereby saving valuable advertising space, and for users to get a more accurate depiction of a product by enlarging on a small depiction.

**Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams and McIntyre further in view of Lyons et al., US 2002/0077937 A1, previously cited (hereinafter referred to as “Lyons”).**

Referring to claim 14. The prior arts Tams and McIntyre teach the method of claim 1, as discussed above, but do not teach wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available. Lyons teaches a method for ensuring availability of inventory for electronic commerce, including wherein a given third party evaluates the request for images or descriptions and automatically indicates whether corresponding items are available (¶¶0045-0046).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior art Tams and McIntyre to include the teachings of Lyons to allow for a given third party to evaluate the request for images or descriptions and automatically indicate whether corresponding items are available. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Lyons that doing so

would provide buyers with confirmation that the desired items are actually available and add them in the purchase decision (§0005).

**Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams and McIntyre further in view of Shmueli et al., US 2002/0143637 A1, previously cited (hereinafter referred to as “Shmueli”).**

Referring to claim 15. The prior arts Tams and McIntyre teach the method of claim 1, as discussed above, but do not teach wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item. Shmueli teaches a portable shopping cart wherein the unique identifier associated with a given item is stored in a user's shopping cart when the user selects the item (§0066).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams and McIntyre to include the teachings of Shmueli to allow for the unique identifier associated with a given item to be stored in a user's shopping cart when the user selects the item. One of ordinary skill in the art would have been motivated to do so based on the knowledge generally available to one of ordinary skill in the art at the time of the invention that doing so would provide for a more seamless and efficient transaction in ensuring that the item desired can be held in a virtual shopping cart before the buyer must make a final determination whether or not to buy the item.

**Claims 18, 19, 65, 66, 73 and 74 are rejected under 35 U.S.C. §103(a) as being unpatentable over the prior arts Tams and McIntyre further in view of Johnson et al., US 6,505,172 B1, previously cited (hereinafter referred to as “Johnson”).**

Referring to claims 18-19. The prior arts Tams and McIntyre teach the method of claim 1, as discussed above, but do not teach the method further comprising automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties (claim 18), nor splitting order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (claim 19). Johnson teaches a method for electronic sourcing of items including automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties (col. 15, line 39 through col. 16, line 15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the method of the prior arts Tams and McIntyre to include the teachings of Johnson to allow for automatically splitting an order including individual order items from more than one third party, and assigning fulfillment of individual order items to the appropriate third parties, and splitting an order including items from the retailer and items from one or more third parties amongst the retailer and the appropriate third parties. One of ordinary skill in the art would have been motivated to do so based on the suggestion taught by Johnson that doing so would allow buyers to purchase from multiple vendors at one session (col. 2, lines 8-22).



Referring to claims 65, 66, 73 and 74. All of the limitations in apparatus claims 65, 66, 73 and 74 are closely parallel to the limitations of method claims 18 and 19, analyzed above, and are rejected on the same bases.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-19, 58-61, 74-67 and 73-79 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The following prior art made of record and not relied upon are considered pertinent to applicant's disclosure. (1) Chui et al., US 6,657,702 B1, discloses a system and method for image print generation and distribution whereby users transmit images to a photo-finisher and orders prints for multiple recipient wherein the prints are encoded with a unique identifier identifying the user recipient and other parameters (see, e.g., columns 10-24); and (2) Igarashi et al., US 2002/0015179 A1, discloses a system and method for providing a print service whereby print order information includes an identification of the user and print parameters making reorders easier (see, e.g., pages 2-9).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS  
October 21, 2008

/Amee A Shah/  
Examiner, Art Unit 3625